

REMARKS/ARGUMENTS

The Pending Claims

Claims 1-16 and 22-25 are pending and are directed to a screening method for a somatic cell nuclear reprogramming substance.

Amendments to the Claims

The claims have been amended to point out more particularly and claim more distinctly the invention.

Claims 1, 7-10, 13, and 15 have been amended to identify the selection step as step (c).

Claims 2, 6, 7, 10-12, and 24 have been amended to recite particular nucleotide sequences for the ECAT1, ECAT2, ECAT6, ECAT7, ECAT8, and ECAT9 genes as supported by the specification at, for example, Table 1.

Claims 21, 33-41, 44-57, and 61-69 have been canceled, since the claims were directed to non-elected subject matter. Additionally, claims 26-32 and 43 have been canceled. Applicants reserve the right to pursue the subject matter of the canceled claims in a divisional, continuation, continuation-in-part, or other application.

No new matter has been added by way of these amendments to the claims.

Summary of the Office Action

The Office objects to claims 1-16, 22-32, and 43.

The Office rejects claims 2, 6, 7, 10, and 11 under 35 U.S.C. § 112, first paragraph, for allegedly lacking written description and enablement.

The Office rejects claims 26-32 under 35 U.S.C. § 102(b) as allegedly anticipated by Ying et al., *Nature*, 416: 545-548 (2002).

The Office rejects claims 26-32 and 43 under 35 U.S.C. § 102(b) as allegedly anticipated by Mitsui et al., *Cell*, 113: 631-642 (2003).

The Office rejects claim 43 under 35 U.S.C. § 102(b) as allegedly anticipated by Ying et al., *Nature Biotechnology*, 21: 183-186 (2003).

Reconsideration of these objections and rejections is hereby requested.

Discussion of the Claim Objection

The Office contends that the selection step in claims 1-16, 22-32, and 43 should be indicated as “step (c).” In accordance with the Office’s request, Applicants have amended claims 1, 7-10, 13, and 15 to identify the selection step as step (c).

Applicants believe that the objection to the claims is moot in view of the amendment to the claims and request that the objection to the claims be withdrawn.

Discussion of the Section 112, First Paragraph, Rejections

The Office contends that, at the time the application was filed, ECAT 1, 2, 6, 7, 8, and 9 had no known function, and, therefore, there was no known assay for determining which amino acids could be altered while retaining the ECAT function. For this reason, the Office contends that the specification only describes and enables the particular sequences set forth in Table 1 for ECAT 1, 2, 6, 7, 8, and 9.

Applicants disagree with the Office’s contention; however, in an effort to advance prosecution, Applicants have amended claims 2, 6, 7, 10-12, and 24 to recite the particular nucleotide sequences for the ECAT1, ECAT2, ECAT6, ECAT7, ECAT8, and ECAT9 genes recited in Table 1 of the specification.

Applicants believe that the pending claims, as amended, are adequately described and enabled by the specification. Therefore, Applicants request that the Section 112, first paragraph, rejections be withdrawn.

Discussion of the Section 102(b) Rejections

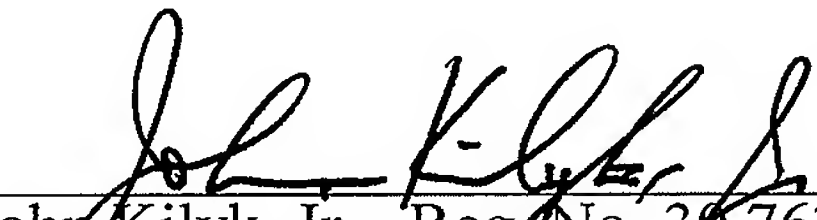
The Office contends that the cells recited in claims 26-32 and 43 are anticipated by Ying et al. (Nature), Mitsui et al., and/or Ying et al. (Nature Biotechnology).

In an effort to advance prosecution, Applicants have canceled claims 26-32 and 43. Applicants believe the anticipation rejections are moot in view of the cancellation of the claims. Therefore, Applicants request that the anticipation rejections be withdrawn.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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